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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,199	01/09/2002	Osamu Takuma	TSL1695	9761

7590 01/29/2003

Robert L. McKellar
Suite # 2
816 West Wackerly St.
Midland, MI 48640-2730

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

56

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,199

Applicant(s)

TAKUMAN ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

-- **Th MAILING DATE of this c mmunication app ars on the cover she t with the correspond nce addr ss --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,7 and 10 is/are rejected.
- 7) ☒ Claim(s) 2,4,5,8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishiumi et al., U.S. Patent # 6,166,121. Nishiumi discloses a curable organopolysiloxane composition that exhibits improved adhesion to various surfaces, especially under severe conditions, by virtue of its inclusion of a calcium carbonate powder having a BET specific surface area of at least 5 m²/g. According to column 2, lines 33-67 through column 3, lines 1-3, the polysiloxane matrix may be any of the previously known curable silicones including the addition curing type which, of course, contain an alkene group-functionalized siloxane polymer component, an organohydrogenpolysiloxane, and a platinum hydrosilylation catalyst which is made available as 100 weight parts relative to 10 to 200 wt. parts of the inorganic filler (column 4, lines 29-32). A mixture of rosin and fatty acid are used in a 1:9 to 9:1 ratio is used to treat the filler prior to its incorporation into the silicone.

While the Examiner concedes that, in each of Nishiumi's primary embodiments, the silicone polymer selected is of the RTV-type as opposed to the addition-curable type mandated by the claim, it has been held that, "disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A

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reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). Therefore, it is proper to rely on this reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 57-195150 A. This reference discloses a silicone rubber composition that demonstrates good deterioration resistance when held in contact with synthetic rubbers or plastics for an extended duration. According to the abstract, the composition is comprised of 100 parts by weight of a vinyl group-functionalized silicone rubber compound to which is added 0.1 to 10 parts by weight of calcium carbonate having a specific surface area of *above* 3.0 m²/g, a hardener, and 5 to 80 parts by weight of fumed silica having a specific surface area of 50 m²/g. Page 2 of the reference reveals that organic peroxides and a combination of an organohydrogensiloxane and catalyst may be employed as the hardener. Said catalysts are the complexes of platinum and palladium known to promote addition-type reactions (page 6). The abstract further states that the base rubber is first prepared by adding blending the fumed silica into the polymer. Thereafter, the remaining materials

are added in a manner consistent with the method of claim 10. The abstract does not delineate whether the base polymer is heated during silicone incorporation.

Nonetheless, it is well within the abilities of one having ordinary skill to determine the conditions needed for efficient mixing of the polymer and silica.

It is noted that, while the reference only broadly discloses the suitable range for the specific surface area of the calcium carbonate as "above 3.0 m²/g" (which certainly would encompass the range set forth by the Applicant), the specific surface areas of the filler materials reported in the exemplary embodiments are below 5.0, the highest of which is 4.7 m²/g (Table 2). Nonetheless, Applicant has not demonstrated criticality for the lower end of the range recited in the claim. Indeed, the Examples compare only the performance of a composition having calcium carbonate of particle size of 17 to 18 m²/g with compositions having calcium carbonate of particle size of 3.4 m²/g. It is impossible to discern from this comparison the criticality of the lower end (5.0 m²/g) stipulated by claim 1. Furthermore, the particles having a specific surface area of 4.7 m²/g are quite similar to those satisfying the lower end of the range. The courts have considered situations such as these and have ruled that, "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected [the claimed product and a product disclosed in the prior art] to have the same properties." *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Therefore, the aforementioned claims are obvious.

A combination of the abstract and a verbal translation of select portions of the Japanese patent were used in determining the applicability this document to the claims. A full written translation will be used to re-evaluate the reference upon receipt of Applicant's response.

Allowable Subject Matter

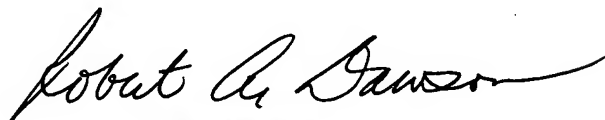
Claims 2, 4-5, and 8-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

January 21, 2003



Robert Dawson
Primary Patent Examiner
Biotechnology Center 1700